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PTO/SB/33 (07-09)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 72882-012 (WRAJ-002)							
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 22, 2010</u></p> <p>Signature <u>/Jessica Brown/</u></p> <p>Typed or printed name <u>Jessica Brown</u></p>		<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number 10/562314</td><td style="width: 50%; padding: 5px;">Filed May 19, 2006</td></tr><tr><td colspan="2" style="padding: 5px;">First Named Inventor COURSE, Philip et al.</td></tr><tr><td style="padding: 5px;">Art Unit 3621</td><td style="padding: 5px;">Examiner AUGUSTIN, Evens J.</td></tr></table>		Application Number 10/562314	Filed May 19, 2006	First Named Inventor COURSE, Philip et al.		Art Unit 3621	Examiner AUGUSTIN, Evens J.
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>47,025</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top;"><p><u>/Gregory Matthew McCloskey/</u> Signature</p><p><u>Gregory Matthew McCloskey</u> Typed or printed name</p><p><u>(617) 535-4065</u> Telephone number</p><p><u>July 22, 2010</u> Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>47,025</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/Gregory Matthew McCloskey/</u> Signature</p> <p><u>Gregory Matthew McCloskey</u> Typed or printed name</p> <p><u>(617) 535-4065</u> Telephone number</p> <p><u>July 22, 2010</u> Date</p>				
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☒ *Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Philip Course et al.
Application Serial No.: 10/562,314
Filing Date: 05/19/2006
Title: **Electronic Transaction System**
Examiner: Augustin, Evens J.
Art Unit: 3621
Atty. Docket No.: 72882-012 (WRAJ-002)
Confirmation No.: 3803
Customer No.: 23630

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RESPONSE TO OFFICE ACTION, MAILED JANUARY 22, 2010

This paper is a response to the final Office Action mailed January 22, 2010 for the above-referenced application and is being filed in conjunction with a Notice of Appeal and Pre-Appeal Brief Request for Review. A petition for a three-month extension of time is also being filed herewith.

Applicants appreciate the Examiner's thorough examination of the subject application, and request reconsideration and further examination in view of the following:

Remarks, beginning on page 2 of this paper.

Authorization is hereby given to charge our deposit account no. 50-1133 for an Extension of Time (three months) under 37 CFR § 1.136, for the Notice of Appeal fee, and any other fees that may be required for the prosecution of the subject application.

REMARKS

Claims 1-42 are pending. Claims 31-42 have been withdrawn and claims 1-30 have been rejected.

Claim Rejections – 35 USC § 102

The Examiner has rejected claims 1-30 as being anticipated by Elston et al. (US Publication No. 2002/0143655) (hereinafter “Elston”).

Applicants respectfully request the Examiner withdraw the anticipation rejections for at least the reasons below.

First, the Examiner has failed to indicate or make clear where Elston discloses or teaches each and every element as set forth in the claims.

For example, in claim 1, the Examiner has failed to indicate or make clear where Elston discloses or teaches:

- i. where the transaction application is operable to generate a user interface using the details and operable to generate a client request for one or more of the electronic goods and/or services;
- ii. whereupon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request;
- iii. in generating the client response, where necessary, issuing a service request to the at least one service provider system and receiving a service response from the at least one service provider; and
- iv. to issue the requested electronic goods and/or services.

Applicants submit that to anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (*see also* MPEP §2131). Furthermore, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art”. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (*see also* MPEP § 2143.03).

Therefore, the anticipation rejection to claim 1 should be withdrawn since the Examiner has failed to indicate or make clear where Elston discloses or teaches every element of claim 1. Similarly, the anticipation rejections to the remaining claims should be withdrawn at least by virtue of their dependency (either direct or indirect) to claim 1.

In addition, the Examiner has also failed to indicate or make clear where Elston discloses or teaches every element of at least the following dependent claims:

Claim 2 - "where the content management system references the matrix in determining the content to be provided to each transaction device of the at least one transaction device to ensure that the set of permissions and/or constraints are complied with".

Claim 3 - "each dimension operable to record information in respect of the transaction device, electronic good or service or merchant, as appropriate, that may affect the content to be provided by the content management system".

Claim 4 - "references the matrix in generating a client response to ensure that the set of permissions and/or constraints are complied with".

Claim 5 - "the transaction device operable to check the set of unique identifiers against content already provided and request content having unique identifiers not already provided from the content management system".

Claims 6 to 8 and 14 to 26 entirely.

Accordingly, Applicants respectfully request that the Examiner withdraw the anticipation rejections to the claims and that the next Office Action (if any) be made non-final.

In addition, Elston fails to disclose or teach each and every element as set forth in the claims.

For example, claim 1 recites:

a host server having an electronic inventory of electronic goods
and/or services;

at least one transaction device having a transaction application ...

where the transaction application is operable to generate a user
interface using the details (of electronic goods and/or services) and

operable to generate a client request for one or more of the electronic goods and/or services,

where upon the at least one transaction device issuing the generated client request to the host server the host server operates to generate a client response in reply to the client request and ... to issue the requested electronic goods and/or services.

For example, according to an aspect of the present invention, the electronic goods and/or services may take the form of movie pass numbers, recharge codes for telecommunications carriers or software (*see* page 14, lines 23 to 24 of the published PCT specification). The transaction application generates a user interface through which a customer interacts to purchase an electronic good or service (*see* page 25, lines 7 to 9 of the published PCT specification). Once the customer's selection has been completed using the user interface, the transaction device generates a client request for the selected electronic good or service and the client request is forwarded to the host server 12 (*see* page 25, lines 10 to 23 of the published PCT specification). The client request is then processed and ultimately the host server is operable to issue the requested electronic good or service to the transaction device (and thus to the customer) (*see* page 30, lines 9 to 19 of the published PCT specification).

Elston fails to disclose or teach at least the above-mentioned features of claim 1 and the above-described aspect of the present invention.

In particular, Elston's system does not relate to an electronic transaction system capable of transacting electronic goods and/or services. In fact, Elston clearly discloses that the invention "relates to a system enabling mobile customers to remotely place orders with any one of a group of affiliated merchants **for pick up by the customer at a specific merchant location**" (emphasis added) (*see* para. [0001] of Elston).

Therefore, it is clear that Elston fails to disclose or teach the above-mentioned features of claim 1. In particular, Elston fails to disclose a system which issues the requested electronic goods and/or services.

The Examiner has appeared to argue that Elston discloses electronic goods and services by referring to the "multimedia objects". Applicants respectfully disagree. The multimedia objects disclosed in Elston do not constitute electronic goods and services. In

particular, Elston discloses that the “multimedia objects contain logos and trademarks (1040), introductory and general information (1046), including frequently asked questions, terms and conditions (1052) ...” (*see* paragraph [0519] of Elston).

Accordingly, since Elston fails to disclose or teach each and every element of claim 1, Applicants respectfully request that the Examiner withdraw the anticipation rejections of claim 1. Similarly, the anticipation rejections of the remaining claims should be withdrawn at least by virtue of their dependency (either direct or indirect) to claim 1.

In addition, Applicants submit that it would not have been obvious to a person skilled in the art to modify Elston to arrive at the claimed invention without impermissible hindsight. For example, Elston specifically teaches away from transacting electronic goods and services (e.g., *see* paragraph [0004] of Elston).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and early notice of the same is earnestly requested.

If a telephone conference will expedite prosecution of the application, the Examiner is invited to telephone the undersigned.

Date: July 22, 2010

Respectfully submitted,

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